

Crookshanks SN 09/588,030

Filed: June 5, 2000

Section 4, Remarks:**REMARKS**

Reexamination and reconsideration of this application is respectfully requested in view of the above Amendments to the Claims and the following Remarks.

The amendments to claims 1, 3 - 6, 11 - 14 and 16 are minor grammatical and spelling corrections. Accordingly, no new matter has been introduced into those claims by the amendments.

The antecedent basis has been corrected for Claim 1, and thus the Section 112 Rejection of that claim has now been rendered moot. Withdrawal of that rejection is respectfully requested.

A typo was corrected in each of claims 3 and 16. The antecedent referents to the steps of claims 4 - 6 were corrected. The identification of the method was corrected in claim 11 to be consistent with the other claims dependent from claim 1. A connective was added after step (d) in claims 12 and 14, and a comma was deleted in line one of claim 13. These are merely clean-up amendments of the grammar and typographical errors to put the claims into immediate condition for allowance. No substantive changes have been made to the amended claims.

Response to the Rejection of Claims:

All 20 claims in this case have been rejected as obvious variations of Lee 5,243,515 and Ferstenberg 5,873,071. The claims do not stand or fall together, and must each be considered on their own merits.

Thus, for example there is nothing in the references that teach associating index references with the topological regions and printing said index references on either the plan sheet or in the contract as called for in claim 6. Likewise, the other claims have distinct features not called for in the references or treated in the rejection. The Office Action is merely a broad brush, overgeneralization of the inventive method, system and programs and misreads both the inventions as claimed and the references in order to make an inappropriate rejection.

The rejection is unsound as based on a misreading of the references and a misunderstanding of the inventive system of topological subdivision and linking those subdivisions to contracts. Upon a better reading of the invention disclosure, the Office will fully understand and will concur that the rejection should be withdrawn.

The principal reference of Lee is NOT as represented in the Office Action. Contrary to the characterization on page 3 of the Detailed Action, Lee does not define a plurality of topological subdivisions of at least one plan sheet, nor does Lee teach or suggest linking subdivision

Crookshanks SN 09/588,030

Filed: June 5, 2000

regions to one of a plurality of contracts. In that mischaracterization, the Office Action refers to Fig 2 of Lee, the item identified as "proj div" (page 3 of Detailed Action).

Rather, the Lee "Proj Div" column in Fig 2 of Lee is only a system for coding bids on project parts to bidders in an XL spread-sheet format. Then, in Fig 3 of Lee, it is seen that the bidder identities are omitted to permit "sealed" or secret bidding. Thus, Lee is no more than a computerized, spread-sheet based system for sealed bidding wherein competing sub-contractors do not learn the identity or the bid amount of their competitors, and the bid awarding entity, e.g., a city or other governmental body, does not know the identity so the bidding process is in accord with the regulations for fair competitive bidding. Lee specifically states in Col 3, lines 4 - 6 that there is no change in the convention sealed bid system.

As Lee notes at the bottom of Col 2, in lines 64 - 68 the principal object of the invention is to provide a secure teleprocessing system in which bid violations are eliminated by ensuring the secrecy and confidentiality of bids. This system of redacting (blocking out or removing the bidders names) in Fig 3 while leaving the amounts in, lets subcontractors educate themselves, e.g., get information by telephone by entering their bidder authorization codes, about the competitive bid amounts without knowing who bid what amount. While that may promote reduction in collusion, it leaves the system open for Joe to call Bill and ask if he was the low bidder.

There is no mention of drawings in Lee. Indeed, the Office is invited to show where it refers to drawings, much less any "topological subdivisions" of the plan sheets as called for in the instant claims (see claim 1, part (a)). Clearly the Office either overlooks or deliberately ignores the reference to "topological subdivision regions" in the claims. That is a primary example of the obvious misreading of the inventive method, system and programs claimed.

There is simply no way to twist the language in Lee, or Ferstenberg for that matter, to cover the process of creating topological subdivision regions in the plan sheets and linking them to contracts, or to incorporate the linked region in to the contract scope of work definition. In fact, the Lee reference is not relevant to the inventive claimed method, system or programs.

Similarly, Ferstenberg is even more irrelevant. Ferstenberg is directed to an order management system for stock trading involving offers and counter offers. Ferstenberg does not discuss construction contracts or the unique problems of completeness in the contract award and construction process. Has everything that needs to be in the building been covered and accounted-for in the bid process? That is a major problem address by the claimed inventive method, system and computer programs. But that problem is not even conceived-of, much less

Crooks & Hanks SN 09/588,030

Filed: June 5, 2000

addressed or solved, by either of the references.

In addition, the Office Action, in its Detailed Action paragraph 7, mistakenly represents that Lee incorporates a linked region into the contract to define a portion of the scope of work, referring to Col 4, line 24 through Col 5, line 10. Nonsense. That disclosure is a discussion of Lee's Figs 5 - 8, which is nothing more than a PBX telephone system linked to a tape recorder and speech synthesizer as a way to create a transaction record and to provide speech to text conversion to build a database record of the contacts by the many subcontractors. In short, it is nothing more than a speech to text system for building an inquiry history database. While the Lee system might be historically accurate regarding who called-in regarding what subcontract when, it does not even remotely address the problem of insuring that the scope of work in a give subcontract is accurate with respect to the drawings. Again, the relied-on section in Lee fails to suggest, much less disclose, anything remotely relating to the topology of the drawings, the plan sheets.

The Office is respectfully requested to NOT ignore the technical terms of this art in the claims.

Contrary to the averment in the Office Action, Ferstenberg is directed to stocks only, not products and services broadly.

The conclusory assertion that it would be obvious to modify Lee's telephone bid communication tracking system with a computer system to process construction contracts for faster and more efficient information exchange is irrelevant and not supported. Note that the conclusion fails to show what elements in Ferstenberg are to be substituted for which elements in Lee. The conclusory paragraph on page 7 of the Office Action fails to mention Ferstenberg at all. Thus, the Office Action is relying on opinion, on phantom prior art. And it does so on the misreading of the invention that it is about faster and more efficient information exchange. In doing so, it ignores the problem of the topological issues between the construction plan sheets and the contracts that is solved, elegantly so, by the inventive process, system and computer programs.

Consider what the law really is: The Court stated in In re Cofer, 148 USPQ 268 at 271 (CCPA):

"Necessarily it is facts appearing in the record, rather than prior decisions in and of themselves, which must support the legal conclusion of obviousness under 35 USC 103. Merely stating that a compound or composition is obvious, without adequate factual support, is not sufficient."

Thus, the misrepresentation of the disclosures in Lee and Ferstenberg amounts to reliance

Crookshanks SN 09/588,030

Filed: June 5, 2000

by the Examiner on phantom prior art, followed by a conclusory, unsupported statement of opinion that the claimed invention is obvious without a shred of factual support. It amounts to merely deeming the claimed invention is obvious. The Board of Patent Appeals and Interferences does not condone that approach, stating in Ex parte Stern, 13 USPQ 2d 1379 at 1381:

"The examiner should be aware that "deeming" does not discharge him from the burden of providing the requisite factual basis and establishing the requisite motivation to support a conclusion of obviousness. [Citing cases] The examiner's reference to unidentified phantom prior art techniques falls far short of the mark. [Citing cases] Accordingly, the examiner's rejection of the appealed claims under 35 USC 103 as unpatentable over any of the primary references, considered singly, is reversed."

Similarly the 103 rejection here should be withdrawn as lacking any factual basis.

Further, with respect to the combination of Lee with Ferstenberg, the fundamental principle, on which the rejections are clearly inappropriate and should be withdrawn, was articulated by the Court of Appeals for the Federal Circuit in In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984). The CAFC there stated the law that governs the Patent Office is that the prior art must suggest the combination of references.

In Gordon, the Court rejected the idea that the prior art devices could be modified to produce the claimed device as a proper basis for an obviousness rejection, holding the combination is not proper unless the prior art suggests the desirability of such a modification. In SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 USPQ2d 1468 (Fed. Cir. 1988), the Court held that to pick and chose elements from references to recreate the invention is not proper. And in Northern Telecom, Inc. v. Datapoint Corp., 15 USPQ2d 1531 (Fed. Cir. 1990), cert. denied, 498 U.S. 920 (1990), the Court held that

"[i]t is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor." (Emphasis added).

These governing principles were applied by the Court in holding in error the obviousness rejections in In re Bond, 15 USPQ2d 1566 (Fed. Cir. 1990) and In re Mills, 16 USPQ2d 1430 (Fed. Cir. 1990). In re Mills specifically held that although the prior art device could be modified to run the way the applicant's device was claimed to run, "there must be a suggestion or motivation in the reference to do so." 16 USPQ2d 1430. Since there was none, the rejection was in error and was reversed. More recently, in Sensonics, Inc. v. Aerosonic Corp., 38 USPQ2d 1551 (Fed. Cir. 1996), the Court reiterated this principle, holding there was no teaching

Crookshanks SN 09/588,030

Filed: June 5, 2000

or suggestion in the prior art that would have led a person skilled in the art to select the specific mechanical and electrical structures and concepts and combine them in the manner of the invention of that case.

Here, the Examiner merely suggests that the inventions are obvious over the references because there would be faster and more efficient information exchange. It is objectionable to Applicant that the Examiner has totally failed to show where in each reference there is the suggestion to combine what teachings with the other reference. Of course, neither Lee nor Ferstenberg has any system for identifying topological regions of plan drawings or to link the defined regions to parts of specific contracts as part of the scope of work. According, the assertion of faster and more efficient information exchange is meaningless.

But equally fatal to the rejection is that there is no teaching or suggestion in either Lee or Ferstenberg to combine the teachings of those references, much less to arrive at the claimed system. So what, if you combine a Ferstenberg computer stock trading system with the PBX voice to text, speech synthesizer or time sequenced record system of Lee? Whatever improved communication system you may have (and what you have is not clear or laid out in the Office Action), it is not what is being claimed. The Lee/Ferstenberg system might be better at exchanging wrong data about what is to be covered in the scope of work of a given subcontractor. It is only the invention that maps the specific plan (drawings) areas to scope of work definitions in the contracts so that nothing is left out; so there is total closure on the entire project scope of work. Who gets the bid, and who bid what when, and how fast a subcontractor was able to find out about his competition, as taught in Lee are irrelevant.

The governing law here was stated by both the Courts and the Board of Appeals. They all have long held that the suggestion for the combination of the references cannot come from the Applicant's Specification, see, for example, Ex parte Brack, 134 USPQ 445 (POBA 1961). The reason is simple: Applicant's Specification is not prior art. Applicant's specification cannot be used as a parts-list to search for disparate parts in the art, and then used as a blueprint to assemble the selected parts. The sources for the motive to select the parts and to reassemble them to obtain the desired result must come from the references.

In essence, the Office Action improperly modifies Lee absent any suggestion, need, or motivation provided by Ferstenberg. That is improper and is not the law. The Rejection obviously uses Applicant's specification as prior art. The suggestion must come from the prior art itself. Ex parte Brack, 134 USPQ 445.

The 103 Rejection is factually in error as to what is asserted as the elements and teach-

Crookshanks SN 09/588,030

Filed: June 5, 2000

ings in the Lee and Ferstenberg references. It selects only certain elements from the references, improperly using Applicant's Specification as the source of the parts list for the selection. Then the Rejection compounds the error by using Applicant's specification as a blueprint from which to assemble these parts in what the Office Action argues is an obvious combination. This is inappropriate as Applicant's specification is not prior art and there is no suggestion in any of the references for either the selection or the combination.

It is clear that the 103 Rejection totally fails to point to any teachings in any of the references for the alleged combination of references. The 103 Rejection is clearly inappropriate and should be withdrawn.

Applicant concurs with the Examiner's view that the remaining references, Nymeyer and Isherwood, alone or in combination with each other or with Lee and Ferstenberg neither teach or suggest the claimed inventions.

CONCLUSION

It is Applicant's view that this Application is now in complete condition for allowance and favorable action is urged. In the event that there remain open issues, or the Examiner does not concur and withdraw the rejection, the Examiner is requested to contact undersigned counsel for Applicant for a telephone Interview to discuss the issues in order to speed this case to an early issue date.

Respectfully submitted,
Rex J. Crookshanks

Date: May 9, 2003

by:


Jacques M. Dulin, Reg. No. 24,067
Attorney for Applicant

Innovation Law Group, Ltd.
Transforming Ideas Into Business Assets®
271 S. 7th Avenue
Suite 24
Sequim, WA 98382-3652
Tel: 360 - 681 - 7305
Fax: 360 - 681 - 7315
e-mail: Dulin@InnovationLaw.com